

REMARKS

Support

The Applicant has amended claim 18 to specify that the invention comprises (c), a metal hydrocarbyl dithiophosphate, wherein component (c) consists essentially of primary metal hydrocarbyl dithiophosphates. Support for this amendment comes from original claim 18 and page 7, lines 4-24 of the specification.

No other elements of the claims have been amended.

Response

The Examiner has rejected claims 18-19, 21-28 and 31-35 under 35 U.S.C. 103(a) as being unpatentable over LeSuer (US 3,708,522) in view of Stewart (US 4,244,279). The Examiner has also rejected claims 18-19, 21-31 and 33-35 under 103(a) as being unpatentable over LeSuer in view of Stewart and further in view of Emert (US 5,498,809). The Examiner has also rejected claim 32 under 103(a) as being unpatentable over LeSuer in view of Stewart and further in view of Byford (US 3,697,427).

The Examiner stated that the declaration filed with Applicant's last response, dated October 10, 2007, was not persuasive because the data was not commensurate with the scope of the claims. The Examiner focused on the fact that the reference samples contained a combination of secondary metal hydrocarbyl dithiophosphate and primary metal hydrocarbyl dithiophosphate, whereas the inventive example contained primary metal hydrocarbyl dithiophosphate. The Examiner noted that the claims allowed for mixtures of primary and secondary metal hydrocarbyl dithiophosphate and so technically included both the inventive and reference samples of the declaration. The Examiner also noted the dispersant was not fully identified in the declaration and so it was not clear if the dispersant was a nitrogen-free dispersant, as the claims require. For these reasons the Examiner concluded the declaration was not persuasive. The Applicant respectfully disagrees.

The dispersant used in the declaration was the same nitrogen-free dispersant described in Example 1 of the specification, on page 16, lines 17-20. This dispersant is a substantially nitrogen free dispersant prepared by the reaction product of a polyisobutylene succinic anhydride and pentaerythritol. This detail was inadvertently left out of the declaration. Applicants are submitting a additional declaration that

makes the identity of the dispersant used clear. In light of this additional information, the dispersant used in the declaration examples does meet the requirements of the claims and so the declaration should not be considered unpersuasive on this point.

Furthermore, the Applicant has amended the claims to specify that the dithiophosphate present consists essentially of primary metal hydrocarbyl dithiophosphate. As the declaration shows that examples containing mixtures of primary and secondary metal hydrocarbyl dithiophosphates do not perform as well as the example that contains only primary metal hydrocarbyl dithiophosphates, the Applicant respectfully submits that the claims now include only the inventive example of the declaration. The reference examples are not covered by the claims as they contain a secondary metal hydrocarbyl dithiophosphate, which affects the performance, and so a material characteristic of the composition. Therefore the present claims cover the inventive example of the declaration and do not cover the reference examples provided.

The Examiner does not appear to dispute the improved performance obtained by the present invention nor that fact that this surprising results provided by compositions containing primary metal hydrocarbyl dithiophosphates, in combination with the other features of the present claims, is not taught by any of the references cited. For these reasons the Applicant respectfully submits that the previously filed declaration demonstrates a surprising result that is obtained by the use of the present invention and that the claims are now in condition for allowance. The Examiner is directed to the previously filed declaration and the Applicant's description thereof, dated October 10, 2007. The Applicant respectfully requests that all rejections be removed and the claims be allowed.

Conclusion

For the foregoing reasons it is submitted that the present claims are in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the undersigned is suggested.

10/802,990, Clason (3270)

The Commissioner is authorized to charge any required fees or credit any overpayment of fees to The Lubrizol Corporation Deposit Account No. 12-2275.

Respectfully submitted,

THE LUBRIZOL CORPORATION

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